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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/536,683

05/27/2005

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HM-629PCT

4620

40570

7590

09/02/2008

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EXAMINER

KEENAN, JAMES W

ART UNIT

PAPER NUMBER

3652

MAIL DATE

DELIVERY MODE

09/02/2008

PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/536,683
Filing Date: May 27, 2005
Appellant(s): ZUG ET AL.

Klaus Stoffel
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/13/08 appealing from the Office action
mailed 6/5/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

A substantially correct copy of appealed claims 1-6 appears on pages 11-12 of the Appendix to the appellant's brief. The minor errors are as follows: in claim 1, line 6, "plate-like" should be inserted prior to --base--.

Note that although the examiner indicated in the advisory action of 12/19/07 that this phrase should be removed from the claim, as had been previously suggested in the

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final rejection, applicant never actually submitted an amendment with such a change (the After-final amendment only corrected one of the two occurrences of the phrase).

Therefore, the currently pending version of the claims (i.e., those submitted in the After-final amendment of 12/10/07) upon which the appeal is based still contains this phrase.

In any event, since this phrase was merely objected to, and was not the subject of any rejection, it has no bearing on the matters to which the appeal is directed.

(8) Evidence Relied Upon

4,971,508	MIYAHARA et al	11-1990
4,312,619	ANDERSON et al	1-1982
3,370,727	SHAW	2-1968
3,341,042	CARDER	9-1967
5,636,713	PERKINS et al	6-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 and 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyahara et al in view of Carder, Shaw, or Anderson et al.

Miyahara shows a conveyance device for metal coils essentially as claimed, including saddle 35, chassis 6, conveyance path 2, 3, drive 8, and means 26 for raising and lowering the saddle along a linear vertical guide 32 on a base frame 25 shaped as a plate, but lacks a scissors unit which provides only linear vertical guidance and two lifting cylinders which provide the sole lifting force.

Carder, Shaw, and Anderson all show mobile lifting platforms wherein scissor units provide only a linear vertical guiding function and separate lifting cylinders provide the sole lifting function (see, e.g., Anderson col. 5, lines 5-15, and col. 7, lines 1-10).

It would have been obvious for one of ordinary skill in the art at the time of the invention to have modified the apparatus of Miyahara with a scissor unit providing only a guiding function and lifting cylinders providing the sole lifting function, as shown by any of Carder, Shaw, or Anderson, to enable the lift to collapse to a minimal height while at the same time providing a guiding function.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyahara et al in view of Carder, Shaw, or Anderson et al, as applied to claim 1 above, and further in view of Perkins et al.

Miyahara as modified does not show a dual stage cylinder lifting system.

Perkins shows a dual stage cylinder lifting system 11, 21.

It would have been obvious for one of ordinary skill in the art at the time of the invention to have further modified the apparatus of Miyahara with a dual cylinder lifting system to increase the lifting height of the system without requiring excessively long cylinders.

(10) Response to Argument

Appellant argues a lack of motivation in combining any of the secondary references with Miyahara, asserting that Miyahara's lifting device is sufficient for the purpose intended and adding a scissor unit would add complexity. Appellant further argues that none of the secondary references deal with lifting heavy objects.

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With regard to the first argument, it is noted that appellant seems to be arguing the base reference Miyahara individually. However, when rejections are based on combinations of references, one cannot show nonobviousness by attacking references individually. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Furthermore, in response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation does not come from the base reference Miyahara, but rather the secondary references, which, as noted above, allow a lower collapsed height of the lifting device.

In response to appellant's arguments concerning the alleged inability of the secondary references to lift heavy objects such as metal coils, the recitation concerning metal coils has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535

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F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Furthermore, the claims make no assertion whatsoever concerning the relative size or weight of the metal coils, and such would not necessarily be any heavier than the objects which the secondary references are capable of lifting. Finally, it is hardly accurate to characterize the secondary references as “light-duty devices”. They are all capable of handling pallets and/or containers of significant size and weight.

It is noted that appellant makes no specific arguments against dependent claims 2-6, and thus no further discussion of those claims is deemed necessary.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/James Keenan/
Primary Examiner
Art Unit 3652
8/26/08

Conferees:

Saul J. Rodriguez /SJR/

Meredith Petravick /mcp/